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Karen A Lowney Esq Estee Lauder Companies 155 Pinelawn Road Melville, NY 11747			WANG, SHENGJUN	
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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 09/248,524

Filing Date: February 09, 1999

Appellant(s): SHAH, AMIT R.

Dorene M. Price
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed January 24, 2005.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The brief does not contain a statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief. Therefore, it is presumed that there are none. The Board, however, may exercise its discretion to require an explicit statement as to the existence of any related appeals and interferences.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 1-22 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) ClaimsAppealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

US Patent 4,761,277	Valdes et al.	August 2, 1988
US Patent 5,874,072	Alwattari et al.	February 23, 1999
US Patent 5,518,728	Burdzy	May 21, 1996

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

1. Claims 1-15, 17, 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valdes in view of Alwattari et al.
2. Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valdes in view of Alwattari et al., and in further view of Burdzy.

These rejections are fully set forth in prior office action mailed July 24, 2003, and reiterated in full below.

(11) Response to Argument

Claims 1-15, 17, 19-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valdes et al. (4,761,277) in view of Alwattari et al. (5,874,072).

The instant invention is directed toward a composition comprising a polymer component selected from acrylic acid derived polymer, acrylic acid derived copolymer, acrylic acid ester derived polymer, acrylic acid ester derived copolymer, a methacrylic acid derived polymer, a methacrylic acid derived copolymer, a methacrylic acid ester derived polymer, and a methacrylic

acid ester derived copolymer, and at least one water soluble organic pigment.

Valdes et al. teach a waterbase lipliner composition in the form of a liquid for use in conjunction with a wick-type nib pen, wherein the composition includes a water-soluble organic pigment, a water-soluble organic polymer film-former, which is a mixture of polyvinylpyrrolidone and polyvinyl alcohol, optional ingredients, and water as a carrier for the pigment. FD&C Yellow 5 is specifically taught as a water-soluble organic pigment. The pigment comprise, preferably, 0.1-5% of the composition. A method of making the composition is taught, wherein the all the ingredients are mixed together. The reference lacks water-insoluble polymeric components. See Col. 1 lines 11-62., Col. 3, lines 15-19., Col. 4, lines 5-37.

However, Alwattari et al. teach water-insoluble polymeric materials in the form of an aqueous emulsion and water soluble, film-forming polymers. Ammonium polyacrylate is taught as a preferred water-insoluble polymeric material that in combination with water-soluble film forming polymers, provides compositions that have superior wear and are removable with soap and water. These polymeric materials are taught as comprising 3-60% of a composition. A method of making the composition is taught, wherein the all the ingredients are mixed together. See Col. 1, line 66-Co1. 2, line 66.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to add the ammonium polyacrylate, taught by Alwattari et al., into the composition of Valdes et al. because of the expectation of achieving a cosmetic product that has superior wear and is removable with soap and water.

Regarding claim 22, it is respectfully pointed out that the intended use of the method of making a composition is not given patentable weight.

Claims 16 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Valdes et al. in view of Alwattari et al. as applied to claims 1-15, 17, 19-22 above, and further in view of Burdzy (5,518,728).

Valdes et al. and Alwattari et al. are applied as discussed above. The reference lacks eyeliners.

Burdzy teaches cosmetic compositions for non-white pigmented skin. Eyeliners and lipliners are taught as interchangeable cosmetic composition forms. See Col. 10, lines 58-65. It would have been obvious to one of ordinary skill in the art at the time the invention was made to teach the combined references in the form of an eyeliner because Burdzy teaches eyeliners and lipliners as interchangeable cosmetic forms.

Appellants assert the teaching of Alwattari et al. (US Patent 5,874,072) as "teaching of specific organic pigments and ~~clay~~ is not a teaching of the water-soluble organic pigments of the present invention," ignoring the fact that Alwattari et al. specifically teach water-soluble organic pigments as the useful pigments in the composition (col. 6, lines 21-31, water-soluble pigments, such as D&C Red No. 6 and No. 7, are listed therein). Appellants made the assertion based on that Alwattari et al. disclosed in the examples that pigments were first mixed with oil phase (col. 7 lines 6-48). The examiner contends that such teaching does not exclusively define the pigments as water-insoluble. Nowhere in Alwattari et al. require the pigments be water-insoluble. Note "oil-soluble or oil dispersible" does not mean water-insoluble. Further, appellants' assertion would be effectively rebutted by the fact that Alwattari et al. list water-soluble organic pigments as the pigments useful in the composition. Alwattari et al. fairly teach

that organic pigments, both water-soluble and water-insoluble, are suitable in the cosmetic composition.

Appellants also argue that Alwattari et al. disclose ammonium polyacrylate as water-insoluble polymer, which is only suitable for emulsion composition. Appellants contend that it would have not been obvious to employ the ammonium polyacrylate in the claimed composition. The arguments are fully considered, but are not persuasive. Particularly, emulsion composition would read on the claimed invention.

Appellants further argue that the combination of Valdes et al, and Alwattari et al. fails to render the claimed invention obvious because "one of ordinary skill in the art would expect water-soluble organic pigments of the '277(Valdes et al) references to be incompatible with the oil containing composition of the '072 (Alwattari et al)." Particularly, appellants assert that water-soluble organic pigments disclosed by Valdes et al. would bleed and/or fade easily in a composition disclosed by Alwattari et al. The arguments are not persuasive. Appellants' assertion is without factual support. Alwattari et al. particularly teach that by using ammonium polyacrylate emulsion, the cosmetic composition will be "superior wear", or resistant to bleed and/or fade. Alwattari et al do not particularly require the organic pigments be water-insoluble.

Appellants argue "one of ordinary skill in the art would not expect water-soluble organic pigments to be protected in the composition of '072 reference (Valdes et al.)" because Valdes et al. teach away from using oil, citing col. 1, lines 22-31 in Valdes et al. It is noted the at what Valdes referred to is the high viscosity of wax and anhydrous (oil) base, not an emulsion as disclosed by Alwattari et al.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the teaching, suggestion or motivation is found both in the cited references and in the knowledge generally available to one of ordinary skill in the art. Particularly, the cited references teach the particular water-soluble organic pigment is known to be useful in cosmetic composition, and the particular polymer herein, ammonium polyacrylate, is useful in cosmetic composition to provide a superior wear of the cosmetics, wherein the cosmetic composition comprises organic pigments. The pigments may be water-soluble or water-insoluble. Therefore, it would have been obvious to one of ordinary skill in the art to make a pigments-containing cosmetic composition with the particular polymer herein, and to enjoy the expected advantage disclosed by the cited prior art.

Appellants' assertion that "one of ordinary skill in the art would not expect the water-soluble organic pigments to be functional unless it was in the water-base system" lacks factual support, and errs logically. There is no evidence or the record, or generally acceptable knowledge in the art, that water-soluble organic pigments have to be used in waterbased system. The premise herein appears to be that every pigment used in cosmetic composition need to be dissolved in the composition. This is obviously not true. There are many pigments, organic, or

inorganic, are not soluble in water or oil, such as some of those disclosed by Alwattari et al. (see, col. 5, line 65 to col. 6, line 40). These pigments are dispersed in the cosmetic composition.

Appellants' remarks about the compatibility of ammonium polyacrylate with water and oil are not persuasive. The intended meanings of "compatible" and incompatible" recited by appellants are not clear. The ammonium polyacrylate disclosed by Alwattari et al. is an emulsion composition, which comprises both water phase and oil phase. Therefore, the polymer would be considered to be compatible with both water and oil.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Note the claimed invention would have been obvious to one or ordinary skill in the art, in view of the cited references as a whole. The ammonium polyacrylate disclosed by Alwattari et al. is an emulsion composition. It would have been obvious to one of ordinary skill in the art, at the time the claimed invention was made, to incorporate the ammonium polyacrylate emulsion disclosed by Alwattari et al. to a cosmetic composition comprising FD&C Yellow 5.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Art Unit 1617

April 2, 2005

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